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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,442

Applicant(s)

WESTERMAN ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 7/12/04.

Claim Rejections - 35 USC § 101

Claims 1-15, 17-20 are rejected under 35 U.S.C. 101 because 35 U.S.C. 101

reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claims 12-15, 17, 19-21 do not set forth a concrete, useful and tangible result. Claims 12 and 19 appear to only require receipt of client information regarding a desire for auto service/scheduling, however as best understood, no service is performed or even scheduled. Applicant should positively set forth a scheduling step and/or a step of performance (if the system is capable of performance) of service based on the received data in order to achieve a concrete, useful and tangible result. Since claims 12 and 19 do not appear at this time to positively schedule the service (as per the 112P2 rejection), the claims are believed to fall short of providing the useful, concrete and tangible result.
- Claims 1-14, 17-22 are rejected under 35 U.S.C. 101 because they are not within the technological arts. Regarding claim 1, applicant's amended language appearing in the claim preamble does not positively set forth computer based steps; such language should be positively included in the steps recited in the body of the claims. Applicant's limitation that a

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request is electronically received is taken to be technology for providing a trivial step; the crux of applicant's invention appears to be the automated *scheduling* which at this time is not set forth within the technological arts.

Claim 1's step of "coordinating...to schedule" does not require any scheduling within the technological arts (i.e. using a computer).

Applicant's included language of "coordinating with at least one with electronically selected automobile service provider" only sets forth a "coordination" step and merely references an electronically selected provider. This claim language does not in fact set forth the electronic selection of the provider. The claim should set forth a step (verb) of "selection" rather than mere description of the type of provider involved (electronically selected – adjective) if this is desired. In summary, claim 1 sets forth only a trivial technology step of receiving a request which could be accomplished by a trivial phone call or FAX; no electronic scheduling (or provider selection for that matter) is set forth. Claims 12, 18, and 19 are similarly analyzed. See the previous office action regarding the requirement for providing a (claimed) invention within the technological arts.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 12-17, 19, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 12, it is unclear if the system performs the actual scheduling or simply receives requested scheduling information. The “receive input scheduling” language is taken to provide only a step of receiving. No scheduling step is set forth and at best any scheduling feature is taken as functional language. This language is interpreted as an equivalent to “receive input for scheduling.” Receiving input of a request for scheduling is a merely preliminary step to the actual subsequent step of performing the scheduling.
- Claim 13 it is unclear if the system performs the selection of a provider or simply receives input requesting selection. The “receive input selecting” language is treated much as the unclear “receive input scheduling” language of claim 12.
- Claim 19, it is unclear what “coordinate the provision” of service requires. Is this simply locating an eligible provider? Determining if a provider is capable of or willing to perform the service? Actually scheduling the service?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 12, 13, 15, 16, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke (Employees snapping up array of volunteer benefits"). Applicant's claim language regarding the "incentive to enter a business relationship/employment benefit" I taken to provide mere functional language and intended use. There are no steps or features of the system claimed that require such a feature. Applicant's functional language regarding who is eligible to carry out the steps or who is eligible to use the system does limit the steps or system.

Regarding claims 1, 2, 6, 18, Kirke nonetheless teaches a business offering employees various benefits to help with recruitment, retention and morale. Kirke suggests offering a car repair pickup and delivery service. It would have been obvious to one of ordinary skill at the time of the invention to have received employee requests for service and to have scheduled car service appointments on behalf of the employee in order to save the employee time and frustration. The scheduled services are future repair services and each includes future car return service. As stated above regarding claims 1 and 18, the selection of the provider is not positively set forth by the claim; the claim merely sets forth "coordination with a provider to schedule," regardless of if the provider can be described as an "electronically selected" provider – the step is one of

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coordination only. It would have been obvious to one of ordinary skill at the time of the invention for a client to have communicated his desire to take advantage of such concierge services by way of any well known communication channel such as by telephone, FAX or email (i.e. electronically) in order to conveniently request service.

Regarding claim 4, as stated above, the steps of the claim are unpatentable over Kirke; the business relationship language is taken to be functional language. However, it would have been obvious to one of ordinary skill at the time of the invention to have offered such a service for any business relationship beyond employee-employer, such as a client entering into a parking contract with a parking contractor, as an additional perk for contract holders.

Regarding claim 5, 12, 13, 15, 16, 19, 20, it was well known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the steps to receive requests for service, select an eligible provider from a collection of participating/approved providers, and to schedule the service, pickup and delivery of the car gives just what one would expect from the otherwise manual steps. In other words, there is no enhancement found in the claimed steps/system other than the known advantage of increased speed, increased accuracy, increased convenience and reduction in human resource(s) to perform/provide the claimed steps/functionality. The end result is the same as compared to the manual method.

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Regarding claims 21, 22, selecting service provider(s) capable of providing the desired services inherently includes selecting a provider(s) who has a history of capably providing such a service. Further, Official Notice is taken that service providers are chosen when previous service provided by them was acceptable/enjoyable. It would have been obvious to one of ordinary skill at the time of the invention to have chosen to return to favorite or recommended providers who have a history of service with customers, so that customers are more likely to avoid poor service providers.

Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Mulebach et al (Retaining tenants with the personal touch). Mulebach et al teaches techniques to retain real estate tenants. Mulebach et al teaches the offering of a concierge desk and a mobile car. It would have been obvious to one of ordinary skill at the time of the invention to have offered the benefits of Kirke's car repair pickup and delivery in order to keep tenants happy.

Claims 7-11, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Lambiase (Re: recent pricing on Civic EX coup). Lambiase teaches the UBS (United Buying Service) which helps users find and purchase cars. Lambiase teaches that such a service is offered by a company to their employees. It would have been obvious to one of ordinary skill at the time of the invention to have additionally offered such a car buying service with that of Kirke. This would provide additional morale, retention and recruitment benefits for the company. Official Notice is taken that

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UBS receives the client's car needs and helps locate and purchase it for them. It would have been obvious to one of ordinary skill at the time of the invention to have scheduled an appointment with eligible dealers so that the client can see and test drive the selected cars.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirke in view of Kuoch (Automatically schedule your car maintenance). Kuoch teaches a computer program that registers a user's car parameters and automatically notifies the user by email when service is due. It would have been obvious to one of ordinary skill at the time of the invention to have provided such an automated car repair maintenance service with the car concierge services of Kirke so that client's can automatically schedule maintenance visits.

Response to Arguments

Applicant argues that simply because one of ordinary skill was capable of automating the manual steps of the cited art, there is no motivation or objective reasoning to do so. As stated above, it was well known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the steps to receive requests for service, select an eligible provider from a collection of participating/approved providers, and to schedule the service, pickup and delivery of the

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car gives just what one would expect from the otherwise manual steps. In other words, there is no enhancement found in the claimed steps/system other than the known advantage of increased speed, increased accuracy, increased convenience and reduction in human resource(s) to perform/provide the claimed steps/functionality. The end result is the same as compared to the manual method.

Applicant argues that because Kuoch teaches a user-based automated car service program, it is improper to combine with a concierge-operated automated car program. Examiner disagrees. The reference is important for what automated functions it accomplishes rather than who operates the system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc